

Remarks

Applicant respectfully requests reconsideration and allowance of the present application in view of the remarks below.

Currently, claims 1-20 are pending including independent claims 1, 14, and 18.

Independent claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2003/0050109 (Caro) in view of U.S. Patent No. 5,158,293 (Mullins). Respectfully, the rejections based on Caro '109 and Mullins '293 should be withdrawn.

Applicant claims an invention where the entry for the instant-win game is not dependent upon or a function of the entry for the base wagering game. However, Caro '109 requires that the player use the same entry for both the instant-win game and the future lottery game. Referring to Mullins '293, Applicant claims an instant-win game with a theme unrelated to the theme of the base wagering game to entice game play. Mullins '293 describes an instant-win game component of a two-part lottery ticket wherein the theme of the instant-win game is purposefully hidden from the player and is not revealed until the player actually plays the instant game. Accordingly, the combination of these two references does not render Applicant's invention obvious pursuant to 35 U.S.C. § 103(a).

Caro '109 states a "problem known in the prior art" is that previous attempts to combine a future draw game and an instant game:

(3) do not allow the same player-selected numbers, whether selected "directly" by the player or through the use of a "quick pick" to be played in both the future lottery games and the instant game

(Caro '109, ¶ 0012.) Caro '109 explains that using the same entry in both games allows the player to have **"multiple play opportunities with his or her selected set of numbers."** (Caro '109, ¶ 0022.) Caro '109 states the purpose for using the same entry for both games is that:

With the same player-selected set of numbers, **play is therefore extended, and play value of the game is increased.**

(Caro '109, ¶ 0049.)

The use of the same entry for both the instant-win game and the base entry game is clearly illustrated in Figs. 3A and 3B wherein the first set of numbers 26-A and 26-B and second set of numbers 30-3A and 30-3B are displayed.

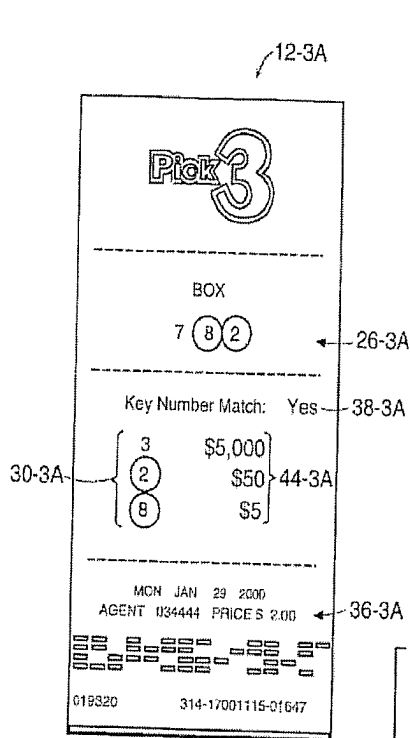


FIG. 3A

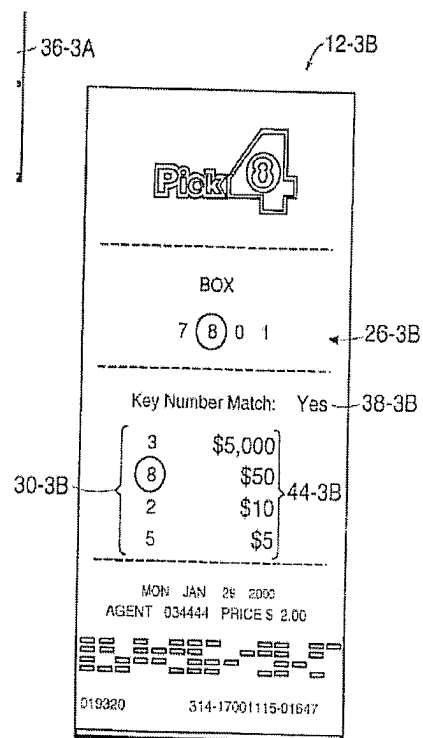


FIG. 3B

Caro '109 explains:

The outcome of the instant game on each ticket is determined by the number selections of that one player

for that one play, and the results of the random number draw for that one play. Also, **the same player-selected number set 26 is used to participate in a second game, the future draw.**

(Caro '109, ¶ 0053.) Accordingly, the instant-win game of Caro '109 is completely dependent upon the player's selection of numbers for the base wagering game. The outcome of the instant-win game in Caro '109 is a function of the first set of player selected indicia. Further, Caro '109 explains that using these interdependent entries is an improvement over games that do not do so and accomplishes the intention of the Caro '109 invention to extend game play and increase game value.

Turning to Mullins '293, the Office Action admits that "Caro et al. fails to teach that the theme of the instant-win game is different from the theme of the base game." (Office Action P. 3, ¶ 6 (emphasis added).) Applicant claims that the theme for the instant-win game is unrelated to the theme of the base wagering game. Respectfully, Mullins '293 does not disclose themes for instant-win games nor does it discuss any relationship between the themes of an instant-win game in relation to a base game.

Mullins '293 describes an instant-win game component of a two-part lottery ticket wherein the theme of the instant-win game is purposefully hidden from the player and is not revealed until the player actually plays the instant game:

Referring again to FIG. 1, half-ticket 11 bears an indication 24 that this half-ticket is the instant game portion of the ticket. The playing area is delineated by being set forth in box 20. The instant play has a **hidden indicator 23 covered by removable material 25.**

In one embodiment the instant game is played by the hidden indicator 23 being a series of letters being printed on the ticket. A winning combination of letters would be any combination of letters which spell the word "LOTTO." Other instant games are known in the art

and could be substituted. **Examples of other instant play games include hidden indicators which include a series of symbols such as bells, cherries, oranges, etc. with a winning combination being a specified series of the same symbols such as 3 bells, 3 cherries or 3 oranges; a series of numbers whose total matches a specified number; or a depiction of playing cards with a winning combination being a winning poker hand or a winning blackjack hand.**

(Mullins '293, Col. 2, l. 51-55; Col. 2, l. 64 – Col. 3, l. 9.) As its name suggests, **the hidden indicator 23 remains hidden until the player scratches away removable material 25 - only then are the various symbols and game theme displayed.**

Mullins '293 does not disclose a particular theme for the instant-win game. It explains that different symbols may be used to indicate a winning ticket. Even if a series of symbols such as cherries, bells or poker hands signifying whether the ticket is a winning ticket constitute a “theme,” which is denied, such “theme” would remain hidden from view until the removable material 25 was removed from the ticket. Thus, the alleged theme would not entice the player to play the instant-win game because the symbols are revealed after the player chooses to play.

Comparing Applicant's Figs. 9 and 10 to Mullins '293's Figs. 1 and 2 clearly shows that Mullins '293 does not teach an instant game with different themes. Applicant's Fig. 9 shows a Keno game and an instant game with a football theme; Fig. 10 shows a Pick 3 game and a black jack theme instant game. Mullins '293 simply shows scratching off the removable material 23 to reveal the symbols underneath:

Applicant's Figs. 9 and 10:

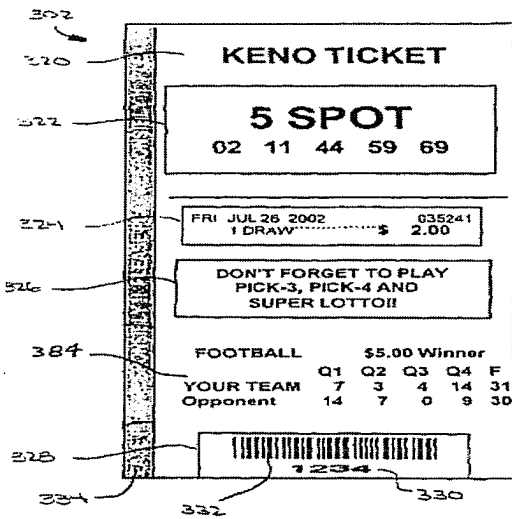


FIG. 9

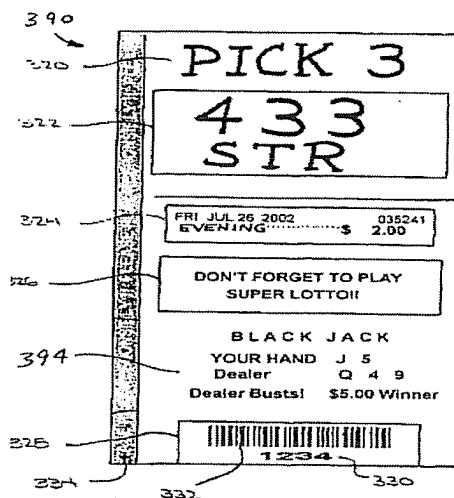


FIG. 10

Mullins '293 Figs. 1 and 2:

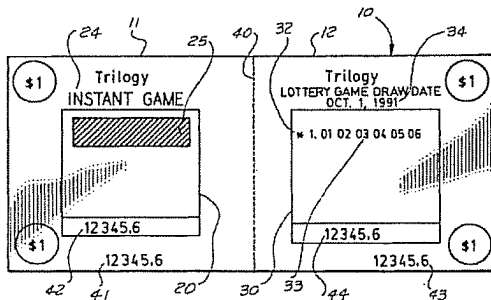


FIG. 1

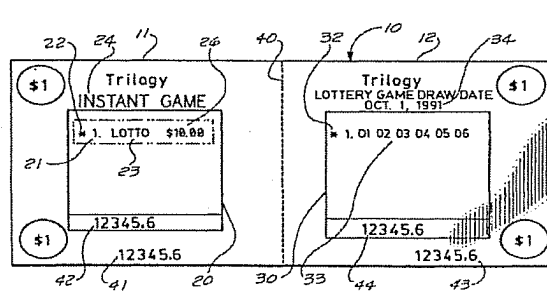


FIG. 2

Applicant claims displaying instant game themes that differ from the base game to entice and encourage instant game play. However, Mullins '293 does teach any relationship between the theme of the instant game and the base game. It simply discloses that various combinations of symbols may indicate a winning ticket. Further, Mullins '293 teaches hidden indicators that are not seen until the player scratches off a removable material. Thus, there is no theme to entice the player to play the game because any possible theme is not revealed until play is complete.

With respect to combining Caro '109 and Mullins '293, one skilled in the art would not be inclined to do so. Caro '109 specifically teaches away from using different

entries for the instant-win game and the base wager game. Further, one would not be inclined to incorporate Mullins '293's use of covered symbols. Applicant's invention seeks to entice game play by using different themes between the instant-win and base wagering game. Plainly, the only incentive or motivation for so modifying Caro '109 using the teachings of Mullins '293 in the manner suggested in the Final Office Action results from using Appellant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art, which is improper under 35 U.S.C. § 103. Accordingly, it is respectfully submitted that any such modification of the cited references relies on the impermissible use of hindsight, which cannot be successfully used to support a *prima facie* case of obviousness. It is respectfully submitted that independent claim 1 is allowable over the combination of Caro '109 and Mullins '293. Further, any dependent claims of claim 1 are allowable for at least the reasons claim 1 is allowable.

Independent claims 14 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2004/0266514 (Penrice) in view of Caro '109 in further view of Mullins '293. The Office Action admits that Penrice '514 does not disclose a base game and an instant-win game and incorporates Caro '109 to attempt to overcome this. The Office Action also admits that the combination of Penrice '514 and Caro '109 fails to teach that the theme of the instant-win game is different from the theme of the base game. The Office Action attempts to overcome this by incorporating the Mullins '293 reference. Respectfully, as explained above, Caro '109 specifically teaches away from combining instant-win games with future draw games where the player uses different entries for each game. Further, Mullins '293 does not disclose an

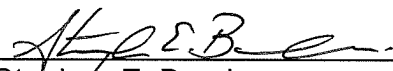
instant-win game with a theme different from the theme of the base game and teaches away from Applicant's invention by hiding the "theme" symbols until they are uncovered by the player scratching away a removable material.

Accordingly, it is respectfully submitted that independent claims 14 and 18 are allowable over the combination of Penrice '514, Caro '109 and Mullins '293. Further, any dependent claims of claims 14 and 18 are allowable for at least the reasons claims 14 and 18 are allowable.

For at least the reasons discussed above, Applicant respectfully submits that the claims patentably define over the cited references. As such, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Should any issues remain after consideration of this amendment, then the Examiner is invited and encouraged to telephone the undersigned. If any fee not accounted for above is required for entry of this Amendment or papers filed herewith, authorization is hereby granted to charge such fee to Deposit Account No. 04-1403. If any petition is required for entry, such petition is hereby made and any associated fees may also be charged to our deposit account.

Respectfully submitted,

DORITY & MANNING, P.A.

By: 
Stephen E. Bondura
Registration No.: 35,070

P.O. Box 1449
Greenville, SC 29602-1449
(864) 271-1592
Fax (864) 233-7342